

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
JEBU JACOB RAJAN : Examiner: H. Vo
Application No.: 09/866,595) : Group Art Unit: 2655
Filed: May 30, 2001) : U.S. Patent No.: 7,072,833 B2
For: SPEECH PROCESSING SYSTEM) : Issued: July 4, 2006
 : September 1, 2006

Mail Stop PTA
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

**REQUEST FOR RECONSIDERATION OF PATENT
TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)**

Sir:

Patentee hereby requests under 37 C.F.R. § 1.705(d) reconsideration and recalculation of the Patent Term Adjustment for the above-identified patent. Submitted herewith is a check for \$200.00 for the fee set forth in 37 C.F.R. § 1.18(e). Any deficiency in this fee may be charged, or any overpayment credited, to Deposit Account No. 06-1205.

For the following reasons, this patent is believed to be entitled to a PTA of 548 days.

1. The present patent issued from Application No. 09/866,595 (the '595 application) filed on May 30, 2001.

2. The present patent is not subject to any terminal disclaimers.
3. Pursuant to 37 C.F.R. § 1.705(b) and (d), reconsideration of the determinations regarding the patent term adjustment (PTA) made for the period prior to the February 1, 2006 mailing date of the Notice of Allowance is not requested.
4. The Patent Application Information Retrieval (PAIR) system indicates a U.S. Patent and Trademark Office (PTO) delay period of 7 days for a period from June 27, 2006 to July 4, 2006. Patentee does not dispute this determination.
5. Patentee filed a “Third Request for Consideration of Previously-Filed Information Disclosure Statement” on February 27, 2006.
6. The PAIR system indicates a Patentee’s delay period of 50 days for an “Information Disclosure Statement” filed on February 27, 2006. Patentee disputes this determination.

ARGUMENTS

1. It is respectfully submitted that the PTO incorrectly treated Patentee’s “Third Request for Consideration of Previously-Filed Information Disclosure Statement” (hereafter referred to as “Third Request”), filed on February 27, 2006, as an “Information Disclosure Statement,” and wrongly deducted 50 days from the PTA.
2. The PTO can reduce the amount of the PTA due to a “failure to engage in reasonable efforts to conclude processing or examination of an application” under 37 C.F.R. § 1.704(c)(10). However, Patentee’s Third Request, filed on February 27, 2006, should not be

considered a “failure to engage” within the meaning of 37 C.F.R. § 1.704(c)(10) for the following reasons.

3. The Third Request was filed in connection with the Examiner’s failure to return to Patentee initialed copies of Forms PTO-1449 timely filed by Patentee during prosecution of the ‘595 application, as explained below.

4. Patentee filed a Fourth Information Disclosure Statement (IDS) with Forms PTO-1449 (three sheets) on March 23, 2004. In the first and second Office Actions, dated April 30, 2004 and January 19, 2005, the Examiner did not return initialed copies of those Forms PTO-1449, nor did the Examiner provide any reason for this or make any mention of the IDS. Patentee brought this matter to the Examiner’s attention in the Amendment and Request for Consideration of Previously-Filed Information Disclosure Statements filed on May 16, 2005. In the third Office Action, dated August 19, 2005, the Examiner still did not return initialed copies of the Forms PTO-1449, nor provide any reason for this or make any mention of the IDS. Patentee again brought this matter to the Examiner’s attention in the Amendment and Second Request for Consideration of Previously-Filed Information Disclosure Statements filed on November 14, 2005. In the Notice of Allowance subsequently issued on February 1, 2006, the Examiner still did not return initialed copies of the Forms PTO-1449, nor provide any reason for this or make any mention of the IDS. Due to the Examiner’s repeated failure to return initialed copies of the Forms PTO-1449, it was necessary for Patentee to file the Third Request for Consideration of Previously-Filed Information Disclosure Statement (“Third Request”), together with payment of the Issue Fee, on February 27, 2006.

5. At the time of preparation of the Third Request, Patentee learned from the Examiner that the Forms PTO-1449 in question had apparently been lost by the PTO, as they were not contained in PAIR. However, despite Patentee's repeated written requests for consideration of the documents cited on the Forms PTO-1449, as set forth above, the Examiner never notified Patentee that those forms were lost or missing from PAIR, nor made any response to Patentee's repeated requests. Accordingly, it was necessary for Patentee to file the Third Request at the time of payment of the Issue Fee.

6. Since Patentee exercised diligence in requesting proper processing of Forms PTO-1449 prior to the mailing of the Notice of Allowance, and since the filing of the Third Request was necessitated by the PTO's apparent mishandling of Patentee's timely and properly filed IDS, the Examiner's failure to return initialed copies of the Forms PTO-1449, as required by M.P.E.P. 609, and the Examiner's failure to take any action in response to Patentee's repeated requests made during the course of prosecution to attend to this matter, Patentee submits that the Third Request, although filed after the mailing of the Notice of Allowance, cannot be considered a "failure to engage in reasonable efforts to conclude processing or examination of an application" under 37 C.F.R. § 1.704(c)(10).

7. In view of the above remarks, it is clear that the February 27, 2006 filing of the Third Request should not cause any reduction in PTA. The filing of the Third Request was necessitated by PTO errors and failures to respond to Patentee's requests to rectify those errors in processing the '595 application, which issued as the subject patent.

RELIEF REQUESTED

Reconsideration of the patent term adjustment is respectfully requested, in which the reduction of 50 days associated with the "Third Request for Consideration of Previously-Filed Information Disclosure Statement," filed on February 27, 2006, be adjusted to 0 days. It is, therefore, requested that the patent term adjustment be recalculated and adjusted to 548 days.

Patentee's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address given below.

Respectfully submitted,



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